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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,648	04/23/2001	Brian Fitzpatrick	MRZ 8996.1	5040
321	7590	01/27/2006	EXAMINER	
SENNIGER POWERS ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/840,648	Applicant(s) FITZPATRICK ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>091401 012904</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed April 23, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. No copy of the article "Build New Contest" was provided and therefore this article was not considered during the examination process.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-38, and 40-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleston et al. (U.S. Patent Number: 6,061,660).

Claim 1: Eggleston discloses a method for allowing multiple customers to each create an individual, modified motivation or recognition program having

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participants, each said program permitting the participants to earn awards on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said method comprising the steps of:

- a. Allowing each customer to electronically access via a customer processor a browsable catalog of predefined programs stored in a storage device; allowing each customer to electronically select via the customer processor one of the predefined programs stored in the storage device (Col 14, lines 6-65)
- b. Allowing each customer to electronically modify via the customer processor at least one component of the selected predefined program. (Col 14, lines 6-65)
- c. Allowing each customer to electronically store via the customer processor the modified program in the storage device for access by such customer; allowing each customer to operate the modified program. (Col 14, lines 6-65)
- d. Providing each customer's participants with access via a participant processor to the modified program stored in the storage device. (Col 14, lines 6-65)

Claim 3: Eggleston discloses the method of claim 1, wherein the awards are award points, and wherein the providing step comprises the step of electronically

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providing each customer's participants with access to a browsable catalog of award items which may be obtained by the participant. (Col 12, line 58 through Col 13, line 6)

Claim 4: Eggleston discloses the method of claim 3, further comprising the step of allowing each customer's participants to electronically redeem the award points for the award items. (Col 21, line 29 through Col 22, line 32)

Claim 5: Eggleston discloses the method of claim 3, further comprising the step of allowing each participant to view data indicating the amount of the award points of such participant. (Col 16, line 46 through Col 17, line 8)

Claim 6: Eggleston discloses the method of claim 3, further comprising the step of allowing each participant to view data indicating transactions by such participant. (Col 16, line 46 through Col 17, line 8)

Claim 7: Eggleston discloses the method of claim 1, wherein the step of allowing each customer to operate the modified program further includes the step of allowing a program processor to generate electronic progress reports for the participants in the modified program indicating program information. (Col 16, line 46 through Col 17, line 8)

Claim 8: Eggleston discloses the method of claim 1, wherein the step of allowing each customer to operate the modified program further includes the step of assessing the customer a fee for the awards as the awards are earned by the participants. (Col 14, line 6 through Col 15, line 15)

Claim 9: Eggleston discloses the method of claim 1, wherein prior to the step of allowing each customer to operate the modified program, including the step of

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allowing the customer to create or review a proposal and/or invoice relating to the modified program. (Col 14, line 6 through Col 15, line 15)

Claim 10: Eggleston discloses the method of claim 1, further comprising the step of allowing each customer to create and receive via electronic mail a proposal and/or invoice relating to the modified program for offline review. (Col 17, line 52 through Col 18, line 31)

Claim 11: Eggleston discloses the method of claim 1, wherein prior to the step of allowing each customer to operate the modified program, including the step of allowing each customer to purchase the use of the modified program. (Col 17, line 52 through Col 18, line 31)

Claim 12: Eggleston discloses the method of claim 1, wherein prior to the step of allowing each customer to operate the modified program, including the step of assessing a fee relating to the modified program. (Col 17, line 52 through Col 18, line 31)

Claim 13: Eggleston discloses the method of claim 12, wherein prior to the step of assessing a fee relating to the modified program, including the step of allowing each customer to create or review a proposal and/or invoice associated with the modified program. (Col 17, line 52 through Col 18, line 31)

Claim 14: Eggleston discloses the method of claim 12, wherein prior to the step of assessing a fee relating to the modified program, including the step of defining the communications campaign of the modified program. (Col 19, lines 32-55)

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Claim 15: Eggleston discloses the method of claim 1, wherein the browsable catalog of predefined programs has a plurality of business challenges, and further comprising the step of allowing each customer to select one of the business challenges to reduce the number of predefined programs of the browsable catalog, which may be selected. (Col 19, line 56 through Col 20, line 32)

Claim 16: Eggleston discloses the method of claim 1, wherein the browsable catalog of predefined programs has a plurality of program types, and further comprising the step of allowing each customer to select one of the program types to reduce the number of predefined programs of the browsable catalog, which may be selected. (Col 19, line 56 through Col 20, line 32)

Claim 17: Eggleston discloses the method of claim 1, wherein each predefined program has a plurality of program components, and further comprising the step of allowing each customer to select at least one of the program components to modify the predefined program. (Col 18, line 64 through Col 19 line 31)

Claim 18: Eggleston discloses the method of claim 1, further comprising the step of enrolling participants in the modified program. (Col 13, lines 7-28)

Claim 19: Eggleston discloses the method of claim 1, further comprising the step of allowing the customer to define participant objectives to be associated with the modified program. (Col 14, lines 26-49)

Claim 20: Eggleston discloses the method of claim 1, wherein a predetermined event is defined, and further comprising the step of terminating the

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operation of the modified program in response to the predetermined event. (Col 14, lines 26-49)

Claim 21: Eggleston discloses the method of claim 20, further comprising the step of allowing each customer to renew the operation of the modified program. (Col 35, lines 3-20)

Claim 22: Eggleston discloses the method of claim 20, further comprising the steps of:

- a. Electronically providing to each customer access to a browsable catalog of previous modified programs of such customer stored in the storage device. (Col 34, line 20 through Col 35, line 37)
- b. Allowing each customer to select via a customer processor one of the previous modified programs or predefined programs stored in the storage device. (Col 34, line 20 through Col 35, line 37)
- c. Allowing each customer to renew via the customer processor the operation of the selected program. (Col 34, line 20 through Col 35, line 37)

Claim 23: Eggleston discloses the method of claim 22, further comprising the step of allowing each customer to modify the selected program. (Col 34, line 20 through Col 35, line 37)

Claim 24: Eggleston discloses a system for allowing multiple customers to each create an individual, modified motivation or recognition program having participants, each said program permitting the participants to earn awards on the basis

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of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said system comprising:

- a. A storage device (Col 11, lines 20-35 and Col 14, lines 6-65)
- b. A program processor connected to the storage device, said storage device storing a program for controlling the program processor, said program processor operative with the program:
 - i. To electronically provide to each customer access to a browsable catalog of predefined programs stored in the storage device. (Col 11, lines 20-35 and Col 14, lines 6-65)
 - ii. To allow each customer to electronically select one of the predefined programs stored in the storage device. (Col 11, lines 20-35 and Col 14, lines 6-65)
 - iii. To allow each customer to modify at least one component of the selected predefined program. (Col 11, lines 20-35 and Col 14, lines 6-65)
 - iv. To allow each customer to electronically store the modified program in the storage device for access by such customer. (Col 11, lines 20-35 and Col 14, lines 6-65)
 - v. To allow each customer to electronically create or review a proposal and/or invoice relating to the modified program. (Col 11, lines 20-35 and Col 14, lines 6-65)

vi. To allow each customer to operate the modified program.

(Col 11, lines 20-35 and Col 14, lines 6-65)

vii. To provide each customer's participants with access to the modified program stored in the storage device. (Col 11, lines 20-35 and Col 14, lines 6-65)

Claim 25: Eggleston discloses a method of allowing multiple customers to create individual, modified motivation or recognition programs having participants, said programs permitting the participants to earn awards on the basis of performance, said programs operating according to customer-selected preferences, said method comprising the steps of:

- a. Electronically providing a selection system which allows each customer access via a customer processor to a browsable catalog of predefined programs stored in a storage device, and allowing such customer to electronically select via the customer processor one of the predefined programs stored in the storage device. (Col 14, lines 6-65)
- b. Electronically providing a modification system which allows each customer to modify via the customer processor at least one component of the selected predefined program. (Col 14, lines 6-65)
- c. Electronically providing a storage system, which allows each customer to store via the customer processor the modified program in the storage device for access by such customer. (Col 14, lines 6-65)

d. Electronically providing a transaction system, which provides each customer's participants with access via a participant processor to the modified program, stored in the storage device. (Col 14, lines 6-65)

Claim 26: Eggleston discloses the method of claim 25, further comprising the step of selectively interconnecting the selection system, the modification system, the storage system, and the transaction system. (Col 14, lines 6-65)

Claim 27: Eggleston discloses the method of claim 25, wherein prior to the step of electronically providing a transaction system, including the step of electronically providing to each customer via the customer processor a proposal system which allows the customer to create or review a proposal and/or invoice relating to the modified program. (Col 14, line 6 through Col 15, line 15)

Claim 28: Eggleston discloses the method of claim 25, wherein prior to the step of electronically providing a transaction system, including the step of electronically providing to each customer via the customer processor an assessment system which assesses a fee relating to the modified program. (Col 17, line 52 through Col 18, line 31)

Claim 29: Eggleston discloses the method of claim 25, wherein the awards are award points, and wherein the step of electronically providing the transaction system includes the steps of electronically providing participants with access to a browsable catalog of award items and allowing each participant to electronically redeem via a participant processor the award points for the award items. (Col 21, line 29 through Col 22, line 32)

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Claim 30: Eggleston discloses the method of claim 29 further comprising the step of allowing each participant to electronically redeem the award points for products and/or services. (Col 21, line 29 through Col 22, line 32)

Claim 31: Eggleston discloses the method of claim 29 further comprising the step of allowing each participant to view data indicating the amount of the award points of such participant. (Col 16, line 46 through Col 17, line 8)

Claim 32: Eggleston discloses the method of claim 25 wherein the step of electronically providing the transaction system includes the step of allowing each participant to view data indicating transactions by such participant. (Col 16, line 46 through Col 17, line 8)

Claim 33: Eggleston discloses a method for allowing multiple customers to each create an individual, modified motivation or recognition program having participants, each said program permitting the participants to earn awards on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said method comprising the steps of:

- a. Electronically providing a series of grouped questions via a customer processor to each customer. (Col 14, lines 6-65)
- b. Electronically allowing each customer to respond via the customer processor to the questions. (Col 14, lines 6-65)

- c. Providing to each customer via the customer processor access to a modified program based on each customer's responses to the questions.

(Col 14, lines 6-65)

- d. Allowing each customer to operate via the customer processor the modified program. (Col 14, lines 6-65)

- e. Providing each customer's participants with access to the modified program. (Col 14, lines 6-65)

Claim 34: Eggleston discloses the method of claim 33, wherein prior to the step of allowing each customer to operate, including the step of allowing each customer to modify the modified program. (Col 34, line 20 through Col 35, line 20)

Claim 35: Eggleston discloses the method of claim 33, wherein prior to the step of allowing each customer to operate, including the step of allowing each customer to create or review a proposal and/or invoice relating to the modified program. (Col 17, line 52 through Col 18, line 45)

Claim 36: Eggleston discloses the method of claim 33, wherein prior to the step of allowing each customer to operate, including the step of electronically assessing a fee relating to the modified program. (Col 17, line 52 through Col 18, line 45)

Claim 37: Eggleston discloses a system for allowing multiple customers to each create an individual, modified motivation or recognition program having participants, each said program permitting the participants to earn awards on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said system comprising:

- a. A storage device storing a browsable catalog of predefined programs. (Col 14, lines 6-65)
- b. A customer processor accessing the stored browsable catalog. (Col 14, lines 6-65)
- c. Selecting software allowing each customer to select via the customer processor one of the predefined programs. (Col 14, lines 6-65)
- d. Editing software allowing each customer to modify via the customer processor at least one component of the selected predefined program. (Col 14, lines 6-65)
- e. Operating software allowing each customer to operate via the customer processor the modified program. (Col 14, lines 6-65)

Claim 38: Eggleston discloses the system of claim 37, wherein the editing software further allows each customer to create or review a proposal and/or invoice relating to the modified program. (Col 17, line 52 through Col 18, line 45)

Claim 40: Eggleston discloses the system of claim 37, further comprising a program processor accessible by the customer processor, wherein the customer processor is remote from said program processor and remote from the storage device, wherein the selecting software, the editing software and the operating software are resident in said program processor and further comprising a network for selectively interconnecting the customer processor and said program processor. (Col 14, lines 6-65)

Claim 41: Eggleston discloses the system of claim 40, wherein the program processor further allows: allocation of the awards to the participants; assessment of a fee relating to the modified program; and issuance of the awards according to the allocation. (Col 14, line 66 through Col 15, line 15; and Col 21, line 29 through Col 22, line 32)

Claim 42: Eggleston discloses the system of claim 40, wherein the program processor generates electronic progress reports for each participant in the modified program indicating performance data for such participant. (Col 16, line 46 through Col 17, line 8)

Claim 43: Eggleston discloses the system of claim 40, wherein the program processor generates electronic progress reports for each modified program of the customer indicating performance data for each program. (Col 18, lines 32-45)

Claim 44: Eggleston discloses the system of claim 40, wherein the customer processor further allows the customer to: enter participant performance data into the program processor; review calculations performed by the program processor in response to the participant performance data; and accept the calculations. (Col 19, line 56 through Col 20, line 32)

Claim 45: Eggleston discloses the system of claim 44, wherein the calculations are ranking of participants and allocation of awards. (Col 19, line 56 through Col 20, line 32)

Claim 46: Eggleston discloses the system of claim 37, wherein the program processor assesses a fee relating to the modified program. (Col 17, lines 8-24)

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Claim 47: Eggleston discloses the system of claim 37 further comprising a participant processor providing participants with access to the modified program. (Col 14, lines 6-65)

Claim 48: Eggleston discloses the system of claim 47, wherein the awards are award points, and wherein the participant processor provides participants with access to a browsable catalog of award items which may be obtained by the participant. (Col 13, line 43 through Col 14, line 5)

Claim 49: Eggleston discloses the system of claim 48, wherein the participant processor allows participants to electronically redeem the award points for the award items. (Col 13, line 43 through Col 14, line 5)

Claim 50: Eggleston discloses the system of claim 49, wherein the participant processor allows each participant to view data indicating the amount of the award points earned by such participant. (Col 12, line 58 through Col 13, line 28)

Claim 51: Eggleston discloses the system of claim 47, wherein the participant processor allows each participant to view data indicating award transactions by such participant. (Col 12, line 58 through Col 13, line 28)

Claim 52: Eggleston discloses the system of claim 37, wherein the operating software notifies the customers when the modified program requires operational maintenance. (Col 35, line 21 through Col 36, line 19)

Claim 53: Eggleston discloses the system of claim 37, wherein the operating software allows the customer to specify a promotion code, and wherein the operating

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software applies one or more terms associated with the promotion code to a purchase by the customer. (Col 34, line 20 through Col 36, line 19)

Claim 54: Eggleston discloses the system of claim 53, wherein the operating software automatically specifies the promotion code and applies the one or more terms to the purchase when the customer navigates from an affiliate web site. (Col 14, lines 6-65 and Col 34, lines 20-53)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (U.S. Patent Number: 6,061,660) in view of Hoffman and Rogelberg ("A guide to team incentive systems", Team Performance Management, v4n1, pp23, 1998)

Claim 2: Eggleston discloses the method of claim 1, but does not describe the specific criteria used to determine award eligibility. However, Hoffman and Rogelberg disclose a number of group based approaches that are commonly used to reward employees (Page 2, line 6, through Page 4, line 54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a criteria in which employees can earn awards based upon the performance of the group. One would have been motivated to include such a criteria in order to

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encourage cross-departmental cooperation and to provide for a fair and equitable distribution of awards.

6. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (U.S. Patent Number: 6,061,660) in view of Symons and Jacobs ("A Total Quality Management-Based Incentive System Supporting Total Quality Management Implementation", Production and Operations Management, Vol. 4, No. 3, Summer 1995)

Claim 39: Eggleston discloses the system of claim 37, wherein the editing software includes an award calculator for recommending an award value for one or more participants based upon any sponsor selected criteria. (Col 19, line 56 through Col 20, line 32). Eggleston does not specifically state that an input salary associated with one or more participants is used as a criterion. However, Symons and Jacobs disclose an incentive program that utilizes and employees base pay in the formula for determining an award (Page 4, Figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate salary into the formula for calculating an award. One would have been motivated to include salary as a criterion for award calculation in order to provide more valuable rewards to key employees of the organization. This would aid the organization in retaining key employees by fostering additional good will and loyalty.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jack et al. (U.S. Patent Number: 5,915,244) discloses a similar incentive program that incorporates a catalog for remote award redemption.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB
jvb

November 30, 2005



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